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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Chiaki Senoo et al.	Art Unit:	1656
Serial No.:	09/831,180	Examiner:	S. Swope
Filed:	August 3, 2001	Customer No.:	21559
Title:	NOVEL TRYPSIN FAMILY SERINE PROTEASES		

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REPLY TO RESTRICTION REQUIREMENT

In reply to the Restriction Requirement that was mailed in connection with the above-captioned case on October 4, 2005, Applicants elect the invention of Group I, claims 1 to 4, and Invention A (SEQ ID NO:2). The election of Group I is made with traverse.

The Office asserts that the inventions listed as Groups I to VIII are not so linked as to form a single general inventive concept under PCT Rule 13.1. In particular, the Office states (page 3):

The technical feature linking Groups I-VIII (A)-(E) appears to be that they

all relate to protease polypeptides. However, protease polypeptides were well known in the art.

Furthermore, the Office cites the Sigma, Inc. 1997 Catalogue ("Sigma") as teaching a partial peptide of a protease polypeptide which anticipates claim 3. Applicants respectfully disagree.

The M.P.E.P. in Appendix AI, Annex B-Unity of Invention, paragraph (c) states that "[u]nity of invention has to be considered in the first place only in relation to the independent claims in an international application and not the dependent claims." In view of this standard, the Office's assertion that claim 3 (dependent on claims 1 and 2) is anticipated by Sigma is irrelevant to the question of unity of the present claims.

Moreover, Applicants submit that the "special technical feature" linking the claims of the present invention is not a "protease polypeptide," but rather novel trypsin-family serine proteases (Tespec PRO) and the genes encoding them. In amending the claims to be directed to the elected sequences, Applicants, in the concurrently filed Preliminary Amendment, have also amended claim 2 to clarify that the trypsin-family serine proteases of the invention are novel and, thus, constitute a "special technical feature" defining a contribution over the prior art.

In particular, part (a) of claim 2 has been amended to limit the number of amino acid deletions, additions, insertions, and/or substitutions to be "up to 30," and part (b) of claim 2 has been amended to recite specific stringent hybridization conditions of "42°C, 2x SSC, 0.1% SDS." The cited art does not describe the trypsin-family serine proteases

recited in the claims, as amended. Accordingly, Applicants submit that concurrently filed claim amendment clarifies that the proteins encompassed by claims 1 and 2 serve as a special technical feature that contributes over the prior art. In view of the above, Groups I to VIII should be rejoined.

Finally, even if the Office maintains that all of Groups I to VIII should not be rejoined, Applicants submit that Groups I (claims 1-4) and III (claim 9) without question meet the requirements for unity of invention. 37 C.F.R. § 1.475(b), regarding unity of invention, states that a national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn to certain combinations of categories. Such combinations include "a product and a process of use of said product" (37 C.F.R. § 1.475(b)(2)). In the present case, Groups I and III are related as a "*product*" (Group I) and a "*process of use of said product*" (Group III). Given, as discussed above, that the "special technical feature" defines a contribution over the cited art, Applicants submit that the claims of Groups I and III fulfill the requirements for unity of invention under PCT Rules 13.1 and 13.2. Accordingly, for these reasons, Groups I and III should be rejoined.